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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,214	06/27/2003	Richard Joseph Morton	MORTON WAX	7318
7590	08/02/2004		EXAMINER	
Risto A. Rinne, Jr. Suite E 2173 East Francisco Blvd. San Rafael, CA 94901			KOSLOW, CAROL M	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,214

Applicant(s)

MORTON, RICHARD JOSEPH

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The disclosure is objected to because of the following informalities:

The use of the trademarks "Briwax Original" and Finish 2001" has been noted in this application. They should be accompanied by their compositions.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

On page 7, line 2, "wax" should appear after "carnauba" and "bees". Applicant should replace all occurrences of "wax" with "polish", with the exception of this change being when the specification discusses carnauba wax and bees wax. This is because the use of the term "wax" in art leads one of ordinary skill in the art to think the taught compositions must contain a wax. The term "polish" more correctly characterizes the taught compositions; especially the aqueous based silicone or silicon resin automobile polishes which do necessarily contain waxes.

Appropriate correction is required.

Claims 1-22 are objected to because of the following informalities: In claims 1-22, all occurrences of "wax" with "polish", with the exception of this change being when the specification discusses carnauba wax and bees wax. This is because the use of the term "wax" in art leads one of ordinary skill in the art to think the taught compositions must contain a wax. The term "polish" more correctly characterizes the taught compositions; especially the aqueous based silicone or silicon resin automobile polishes which do necessarily contain waxes. In claim 6, "wax" should appear after "carnauba" and "bees". In claims 4, 12 and 17, "original" is missing from the given trade name.

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Claims 1-18, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The actual composition of the wax emulsions of claim 1-18 is not defined and can not be determine from the teachings of the specification. Polishes are composed of a multitude of ingredients all in differing amounts, as shown by the provided patents. Furniture and automobile polishes all have different viscosities, forms, and contents. Both types of polishes can in the form of emulsions. Thus it cannot be determined what is the actual composition or type of emulsion is being claimed, a water-in-oil, an oil-in-water or a double emulsion. The fact the amounts of each type of polish is known does not teach the composition since the amount of water, oil and the polishing component, such as a wax, an organosilicon compound, a film forming polymer and any combination of these components are not defined or given.

Claims 4, 5, 12, 13, 17 and 18 contain the trademark/trade names "Finish 2001" and "Briwax Original". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the polishes and, accordingly, the identification/description is indefinite.

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Claims 21 and 22 are improperly dependent on claim 19. Claim 19 is directed to a method of making the polish, while claims 21 and 22 are directed to a method of using the polish.

Finally, claims 2 and 3 are duplicate claims, claims 10 and 11 are duplicate claims and 15 and 16 are duplicate claims. These sets of claims give two different ways of claiming the same thing, that the first quantity is 50 vol% or less and the second quantity is 50 vol% or more. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is reject both claims as being substantial duplicates of each other. See MPEP § 706.03(k).

The Examiner is interpreting the composition of claims 1-3, 6-11 and 14-16 as comprising an emulsion comprising oil, water and two polishing components. The preferred amount of oil phase is greater than 0 up to 50 vol%, preferably greater than 0 up to about 33 vol% and that the first polishing component is a hydrocarbon, bees wax or carnauba wax and the second polishing component is silicone, a polymer and silicone resin.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 3,847,622.

Both of these references teach polish emulsions which can be used on furniture comprising water, an oil based solvent, organosiloxane and a wax, such as a bees wax or

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carnauba wax. Organosiloxane is a silicon resin or silicone wax. The emulsion in U.S. patent 3,847,622 contains 50-84 wt%, which when converted to volume percent is about the same as the taught weight percent. The converted volume percent falls within the claimed ranges. The reference teaches the claimed composition.

The provided WebPages given the components of "Briwax Original" and the main components of "finish 2001". They do not teach the generic compositions of these polishes.

Claims 19 and 20 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

There is no teaching or suggestion in the cited art to form a polish by mixing an oil-based furniture polish and a water-based automobile polish.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (571) 272-1362.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
July 26, 2004



C. Melissa Koslow
Primary Examiner
Tech. Center 1700